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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/848,642 | 05/03/2001 | Shunpei Yamazaki | SEL 258 | 7227 |

7590 04/04/2008
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| EXAMINER |
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SCHECHTER, ANDREW M

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| ART UNIT | PAPER NUMBER |
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2871

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| MAIL DATE | DELIVERY MODE |
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04/04/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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|------------------------------|--------------------------------------|--|--|
| Office Action Summary | Application No. 09/848,642 | Applicant(s) YAMAZAKI ET AL. | |
| | Examiner ANDREW SCHECHTER | Art Unit 2871 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 January 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-24, 76, 77 and 85-100 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-24, 76, 77 and 85-100 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>1/9/08</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

The applicant has amended the electrode structure limitations of the claims to overcome the double patenting rejections over US 7,023,021. However, the amended claims now recite electrode structure which is claimed in US 6,580,475, US 7,084,019, and US application 11/460,105, as discussed below.

The amendments to claims 91 and 92 (adding the electrode structure limitations) overcome the previous prior art rejections in view of *Yokomizu*, which are therefore withdrawn.

Double Patenting – Non-Statutory

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to

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be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 21-24, 76, 77, and 85-100 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,580,475 in view of *Yokomizu*, Japanese Patent Document No. 10-073813, *Nagayama et al.*, U.S. Patent No. 5,680,187, *Kanemoto et al.*, U.S. Patent No. 5,493,429 and *Yoneya et al.*, U.S. Patent No. 6,300,926.

The patented claim 1 recites the electrode structure of claims 21, 76, 91, and 92, while the details of the overlapping colored layers and organic resin film would have been obvious to one of ordinary skill in the art at the time of the invention in view of *Yokomizu*, *Nagayama*, *Kanemoto*, and *Yoneya* as discussed in the rejections under 35 USC 103 in the office action of 9 October 2007. Claims 21, 91, and 92 are therefore rejected. Use in a portable telephone would have been obvious to one of ordinary skill in the art at the time of the invention, so claim 76 is also rejected. The additional limitations of claims 22-24, 77, 85-90, and 93-100 are met by those references or obvious to one of ordinary skill in the art at the time of the invention over them.

4. Claims 21-24, 76, 77, and 85-100 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 7,084,019 in view of *Yokomizu*, Japanese Patent Document No. 10-073813, *Nagayama et al.*, U.S. Patent No. 5,680,187, *Kanemoto et al.*, U.S. Patent No. 5,493,429 and *Yoneya et al.*, U.S. Patent No. 6,300,926.

The patented claim 1 recites the electrode structure of claims 21, 76, 91, and 92, while the details of the overlapping colored layers and organic resin film would have been obvious to one of ordinary skill in the art at the time of the invention in view of *Yokomizu, Nagayama, Kanemoto, and Yoneya* as discussed in the rejections under 35 USC 103 in the office action of 9 October 2007. Claims 21, 91, and 92 are therefore rejected. Use in a portable telephone would have been obvious to one of ordinary skill in the art at the time of the invention, so claim 76 is also rejected. The additional limitations of claims 22-24, 77, 85-90, and 93-100 are met by those references or obvious to one of ordinary skill in the art at the time of the invention over them.

5. Claims 21-24, 76, 77, and 85-100 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 11/460,105 in view of *Yokomizu*, Japanese Patent Document No. 10-073813, *Nagayama et al.*, U.S. Patent No. 5,680,187, *Kanemoto et al.*, U.S. Patent No. 5,493,429 and *Yoneya et al.*, U.S. Patent No. 6,300,926.

The copending claim 1 recites the electrode structure of claims 21, 76, 91, and 92, while the details of the overlapping colored layers and organic resin film would have been obvious to one of ordinary skill in the art at the time of the invention in view of *Yokomizu, Nagayama, Kanemoto, and Yoneya* as discussed in the rejections under 35 USC 103 in the office action of 9 October 2007. Claims 21, 91, and 92 are therefore rejected. Use in a portable telephone would have been obvious to one of ordinary skill in the art at the time of the invention, so claim 76 is also rejected. The additional

limitations of claims 22-24, 77, 85-90, and 93-100 are met by those references or obvious to one of ordinary skill in the art at the time of the invention over them.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew Schechter whose telephone number is (571) 272-2302. The examiner can normally be reached on Monday - Friday, 9:00 - 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Nelms can be reached on (571) 272-1787. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Andrew Schechter/
Primary Examiner, Art Unit 2871
Technology Center 2800
28 March 2008